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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,561	10/24/2001	James P. Donelan	112692-006	5058

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 10/24/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/003,561

Applicant(s)

DONELAN, JAMES P.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Lassoff. Hare discloses in column 3, line 55 to column 5, line 45 of the specification a folder comprising a transparent flexible body having an integrally formed erasable writing surface. As a folder, it is inherently bent at one end. This fold represents a bent end capable of removably securing a sheet of paper to the body. Column 3, lines 54-6 and column 7, lines 15-27 in particular discusses the erasable writing characteristics of the transparent member of the folder. A user can write on both sides of the folder. Hare fails to disclose that the folder comprises a dry erase board. Lassoff discloses in column 2, line 64 to column 3, line 14 of the specification a transparent sheet of plastic which can be used as a dry erase board. It would have been obvious to one of ordinary skill in the art to modify the device disclosed by Hare by providing a dry erase surface to the folder for the purpose of allowing a user to more easily remove markings from the sheet, without the using of cleaning chemicals. It is believed that the folder of Hare inherently

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comprises a semi-rigid body, because the folder inherently must be able to maintain its shape to be folded into a folder and to store an indicia bearing sheet, and because applicant's specification fails to define "semi-rigid" in some way as to clearly define some structure which is lacking in the Hare disclosure. Also, applicant discloses that its dry erase board as comprising a polypropylene film or a polyethylene film, without disclosing any additional materials which would impart semi-rigidity to the body. Both of these materials are disclosed in column 4, lines 1-3 of Hare. To the extent that Hare fails to disclose a semi-rigid body, Lassoff discloses in column 3, lines 7-14 that its transparent dry erase sheet may be laminated to a heavier material to provide strength and body to the sheet, thus suggesting the use of a semi-rigid body to provide a more stable dry erase surface. With respect to claim 13, the sheet inserted into the device is artwork which is to be copied, and thus has indicia thereon, as discussed in particular at column 5, lines 54-65.

3. Claims 3, 6-8, 10, 14, 15, 17 and 18 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Weinthrop. Hare discloses all of the limitations of claim 3, 6-8 and 10 with the exception of the second bent end of the body. Folders having a plurality of bent ends are well known. Weinthrop discloses in Figure 1 one such folder, wherein the body 2 comprises bent sections 12, 7 and 10, which are folded to allow the device to retain sheets of paper. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey by providing a plurality of bent sections to the body for the purpose of more securely retaining the sheet of paper within the device. The bent ends contact various surfaces and edges of the sheet. With respect to claims 14 and 15, Weinthrop discloses in column 1, lines

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62-67 that the bending of the sections forms a pocket. With respect to claim 18, the front surface of the folder disclosed by Hare has a dry erase surface, as discussed above.

4. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Ko. Hare discloses all of the limitations of claims 2 and 12 with the exception of the device being flat when shipped. It is known to ship folding items in an unfolded state. Ko discloses in column 1, lines 53-60 of the specification one example of folding binders which are shipped in a flat state. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare by providing the device in a flat state when shipping for the purpose of making the device less thick, and thus easier to ship in larger numbers.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Mogelonsky. Hare discloses all of the limitations of claim 11 with the exception of the use of adhesive. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Winfrey by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Weinthrop, and further in view of Mogelonsky. Hare as viewed in combination with Weinthrop discloses all of the limitations of claim 16 with the exception of the use of adhesive to attach the

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pocket. Adhesive is a well known means of attaching elements of a folder. Mogelonsky discloses in column 7, lines 40-43 of the specification one example of a folder which comprises adhesive 29, which is used to attach members 26 and 14 to form a pocket 30. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare as viewed in combination with Weinthrop by providing adhesive for the purpose of more securely assembling the folder to retain a sheet of paper.

7. Claims 19 and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hare in view of Schwartz. Hare discloses all of the limitations of claims 19 and 20 with the exception of the open back. Schwartz discloses in Figures 4 and 4a a folder comprising one open side, which could be the back depending on how the device is positioned. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Hare by providing a device with an open back for the purpose of providing easier access to a sheet of paper retained therein.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments concerning the "semi-rigidity" of the body are addressed in paragraph 2 above. Also, it is not at all clear how Hare fails to disclose a folder having two sides which can be written on. Column 4, lines 15-19 disclose that in one embodiment of the device, the second member of the folder is of the same material as the first member, and thus can inherently be written on. Figure 1, cited by applicant in the argument,

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appears to be showing a second embodiment of the invention, discussed at column 5, lines 24-35. Because the folder is a separate entity, and does not appear to be fixedly attached to a table or some other surface, both surfaces of the folder of Hare can be written on at the same time.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Donelan discloses a dry erase board comprising a polyethylene or polypropylene film.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

*Kurt Fernstrom*  
Kurt Fernstrom

October 17, 2003